

## REMARKS

### I. Prosecution History.

Claims 1-78 were originally submitted for examination with filing of the present nonprovisional patent application, which claims priority to provisional patent application 60/214,339 filed June 27, 2000. Four groups of claims were identified in a four-way restriction, of which Applicant selected Group I, Claims 1-31, for examination. Claim 32-78 remain withdrawn from examination.

In the first Office Action, the elected claims, 1-31, were rejected by the Examiner under 35 U.S.C. §102(e) and §103(a). More particularly, Claims 1 – 11 and 14 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,625,580 (hereinafter referred to as "*Tayama*"), while Claims 12 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Tayama* in view of U. S. Patent No. 6,076,167 issued to Borza (hereinafter referred to as "*Borza*"), and 13 and 15-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Tayama* in view of U. S. Patent No. 6,360,101 issued to Irvin (hereinafter referred to as "*Irvin*"). In response, the applicant has amended Claims 1-2, 4-9, 13-19, 22, 25-32; and added new claims 79-104.

In the second Office Action, made Final, the Examiner rejects claims 1-4, 30, 31, 79, 80, 82, 83, 85-86, 89-93 and 98-105 under 35 U.S.C. 102(e) as being anticipated by Eldridge et al. Claims 5, 87 95 and 96 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of Kaplan. Claims 6-9, 13, 15-20, 22-24, 26, 28 and 29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of Cromer et al. Claims 10 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of Challenger et al. Claim 12 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of Cromer et al, and further in view of *Broza*. Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of *Ronen*. Claims 81 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Eldridge et al in view of Boyle. Claims 88 and 94 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Eldridge et al* in view of *Magro et al*. Claims 11 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Eldridge et al* in view of *Cromer et al*, and further in view of *Magro et*

*al.* Claims 25 and 27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Eldridge et al* in view of *Cromer et al*, and further in view of *Kaplan*. Finally, claim 97 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Eldridge et al* in view of *Kaplan*, and further in view of *Magro et al*.

In response to the Second Office Action, claims 5, 25-29, 83-87, 95, 96 and 103 are cancelled and claims 1, 7, 8, 15-19, 30, 31 79 and 100 are newly amended. Claims 1-4, 7-24, 30, 31, 79-82, 88-94, 97-102, and 104-105 remain pending in the application. Claims 32-78 remain withdrawn.

## II. Features of the Invention Summarized.

The present invention is useful to handheld wireless device users that are mobile (e.g., traveling and/or in-between familiar or assigned enterprise data networks), have immediate requirements for a means to render (e.g., print, display, manipulate) electronic data on a device other than their wireless device, and are not familiar with locations of nearby data rendering devices capable of meeting the user's rendering requirements.

One important feature of the present invention is that a user can use his/her personal wireless device (WD) to request the support of a network to locate a data rendering means (DRD) not previously assigned to a WD and located in a fixed location that is accessible to wireless device user. DRDs include printers, video displays, presentation projectors, Internet kiosks, ATMs, etc., that are made available to mobile wireless device users, e.g., installed in public terminals or within retail establishments.

Another important feature of the present invention is that wireless device users can use their WD to locate a DRD and can request the network supporting the WD to transfer data to the DRD over networks. The data associated with the wireless device can be obtained from memory or a mailbox associated with the wireless device user and accessible by the network supporting the WD.

Yet another important feature of the present invention is that wireless devices can be used to: control unassigned, user accessible data rendering device; manipulate data after it is transferred to the unassigned, user accessible data rendering device before or during data rendering; and check the operational readiness of data rendering devices before or during data rendering.

Public data networks and servers (e.g., telecommunications provider equipment) can be utilized to coordinate data rendering device location based on wireless device location, delivery of data to data rendering devices, and access to data rendering devices. Pass codes and encryption can be used to permit the rendering of data at DRDs.

Applicant's claims as amended fully support the above-described methods and capabilities and are supported by the extensive specification submitted by Applicant.

### **III. Features of *Eldridge et al* (U.S. 6,515,988) – the primary reference.**

*Eldridge et al* requires a DRD to accept a token identifying the data's location in/at a remote source directly from the WD prior to obtaining the data from a remote data source (e.g., server memory, network URL/address). Given this requirement, it is clear that the wireless device user must know the identity and the location of the DRD. The transfer of a token to a DRD cannot occur unless the DRD's identity and location is first known by the WD user. Once a token identifying where the data is located is received by the DRD from the WD, the DRD can retrieve the data over a data network from its stored location where it can thereafter be rendered by the DRD. *Eldridge* does not teach direct rendering of data from WDs. The main purpose of *Eldridge* is to provide an alternative to directing rendering by providing tokens identifying locations from which a DRD can obtain data other than directly from a WD.

### **IV. Rejection of Claims 1-4, 30, 31, 79, 80, 82, 83, 85-86, 89-93 and 98-105 under 35 U.S.C. 102(e) as being anticipated by *Eldridge et al*.**

Claims 5, 83-86 and 103 have been cancelled. Claims 1-4, 30, 31, 79, 80, 82, 89-93, 98-102 and 104-105 remain pending with respect to this rejection. Claims 2-4 stand or fall based on the disposition of independent claim 1, and claims 31, 79, 80, 82, 89-93 and 98-99 stand or fall based on the disposition of independent claim 30. Claims 1 and 30 are discussed in detail with respect to the rejection.

#### **Requirements for *Prima Facie* Anticipation**

"Anticipation requires the disclosure in a single prior art reference of each

element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicant's claims, *Eldridge et al* must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicant need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that *Eldridge et al* fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

#### **Application of Anticipation Requirements**

Applicant's independent claims as amended provide that data is transferred to a DRD through a network at the request of the WD. The transfer of data only occurs after a DRD is identified by the WD to the network. Applicant's claims, as amended, read as follows:

1. A method of brokering data between handheld wireless devices and data rendering devices, comprising:

selecting data from a wireless device (WD) for rendering;

selecting a data rendering device (DRD) not assigned to said WD and located in a fixed location accessible by a WD user; and

transferring the data to said DRD following commands entered by the WD user at said WD via a network supporting said DRD only after the WD user identifies the DRD to a network supporting said WD, wherein the network supporting said WD facilitates transfer of the data from memory associated with the WD to the DRD through the network supporting said WD and the network supporting said DRD.

30. A method of brokering data between wireless devices and data rendering devices, comprising enabling a user of a wireless device (WD) to perform the following steps:

requesting support from a network supporting the WD to assist the user in locating at least one data rendering device (DRD) not assigned to the WD and physically accessible to the user of the WD, said locating executed by the network in accordance with a WD profile located in at least one of the WD and/or the network;

selecting a DRD for rendering data;

selecting data for rendering at the DRD; and

providing the data via the network supporting the WD to the DRD for rendering.

*Eldridge et al*, in contrast to Applicant, does not identify the DRD to a network prior to rendering data. *Eldridge* only identifies to a DRD (as opposed to a network) the identity of data and its location for retrieval and rendering using a token, which provides instructions and authorization to retrieve the document from a remote resource. The DRD must then obtain the data for rendering based only on information provided in the token. *Eldridge et al* and Applicant's approaches to rendering data at the request of a wireless device are completely different, therefore anticipation can not be supported under 35 U.S.C. 102(e). For the above stated reasons, Applicant respectfully traverses the rejection of claims 1 and 30. Claims 2-4 and 31, 79, 80, 82, 89-93, 98-99 depend, respectively, from claims 1 and 30; therefore, the allowability of the dependent claims will be dependent on the disposition of claims 1 and 30. Given the remarks provided herein in support of claims 1 and 30, Applicant, also traverses the rejection of dependent claims 2-4, 31, 79, 80, 82, 89-93, 98-99 and respectfully request their reconsideration along with claims 1 and 30.

**Application of the Anticipation Requirements to the Rejection of Claims 79, 80 and 82.**

The Examiner rejected dependent claims 79, 80 and 82 under 35 U.S.C. §103(a) as being obvious over *Eldridge et al.* The Examiner cites specifically to col. 7, lines 44-54, col. 9, lines 35-45, 61-67, and col. 10 lines 1-6 as describing a wireless device user profile associated with a WD that is used to negotiate requests with a network supporting the WD when locating a printer.

Applicant has carefully reviewed the cited sections of *Eldridge et al.*, and must respectfully disagree that the concept of using a user profile in selecting a printer location is being taught. The section of the *Eldridge* patent cited by Examiner teach that location parameters associated with identifying the document device, local name of the device, location of the device, and time when and country where the request was made can be recorded when the wireless device is negotiating a token with the rendering device. Reference to a user profile is nowhere listed or described in the cited sections. It is clear from the cited sections of *Eldridge* that the location/device parameters described therein are simply used as historical references over rendered documents, but not as key information used to help a wireless device user find a particular capability or location for a data rendering device.

**IV. Rejection under 35 U.S.C. 103(a) of: Claims 5, 87 95 and 96 as being unpatentable over Eldridge et al in view of Kaplan; Claims 6-9, 13, 15-20, 22-24, 26, 28 and 29 as being unpatentable over Eldridge et al in view of Cromer et al; Claims 10 and 21 as being unpatentable over Eldridge et al in view of Challenger et al; Claim 12 as being unpatentable over Eldridge et al in view of Cromer et al, and further in view of Broza; Claim 14 as being unpatentable over Eldridge et al in view of Ronen; Claims 81 as being unpatentable over Eldridge et al in view of Boyle; Claims 88 and 94 as being unpatentable over Eldridge et al in view of Magro at al; Claims 11 as being unpatentable over Eldridge et al in view of Cromer et al, and further in view of Magro et al; Claims 25 and 27 as being unpatentable over Eldridge et al in view of Cromer at al, and further in view of Kaplan; claim 97 as being unpatentable over Eldridge et al in view of Kaplan, and further in view of Magro at al..**

Claims 5, 25-29, 87, 95, and 96 have been cancelled. Claims 6-14 ultimately depend from claim 1, which was discussed above. Claims 16-24 ultimately depend from claim 15. Claims 31, 88, 94, 97 ultimately depend from claim 30. Claims 15 and 30 are

discussed in detail as follows.

**Requirements for Prima Facie Obviousness.**

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. *the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).*

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

**Application of the Obviousness Requirements to independent Claims 15 and 30 based on Eldridge et al..**

Applicant respectfully submits that rejection against independent claims 15 and 30, and ultimately their respective dependent claims ( and ), fails under the third prong of the obviousness test for the reasons subsequently discussed *infra* against *Eldridge et al.*, the primary references cited against Applicant's claims. *Eldridge*, neither alone or in combination with any of the listed references (*Kaplan*, *Cromer et al*, *Challenger et al*,

*Borza, Ronen*) teach or suggest all of the limitations set out in independent Claims 15 and 30. In fact *Eldridge* teaches away from the process claimed by applicant because Eldridge does not want to request a document transfer from a network to the DRD but instead Eldridge requires the DRD to obtain a document given information provided in a token.. Claim 30 is illustrated above. Claim 15 has been amended to read as follows:

15. A method of brokering data between a wireless device and a data rendering device (DRD) not assigned to a wireless device (WD) and accessible to WD users, wherein a WD user performs the following steps at the WD:

selecting data for rendering data at a DRD;

entering a DRD locator request with a network supporting the WD to find at least one DRD currently located near the WD;

receiving location information at said WD for the at least one DRD located near the WD and accessible to the WD user;

selecting a DRD for rendering the data; and

requesting at the WD that the data be transferred to said DRD through the network supporting the WD.

Rejection of claims 15 and 30 fails to satisfy the third prong because, despite the objectives and teachings of the references none of them in combination teach or suggest methods of finding a DRD using wireless device network resources and delivering data to be rendered at a DRD via networks at the request of a WD. Because combining any of the cited references does not address all of the elements to provide the functionality and benefits to wireless device users as described and specifically claimed by Applicant in independent claims 15 and 30, the rejection of claims must be respectfully traversed.

#### **V. The addition of a new dependent claim 100.**

Applicant has amended claims 100 to become a new independent claim. Claims



101, 102, 104 and 105 depend from claim 100. No new matter has been added with the amendment of claim 100. Claim 100 is written as follows:

100. A method of brokering data between handheld wireless devices and data rendering devices, comprising:

selecting data from a wireless device (WD) for rendering;

selecting a data rendering device (DRD) not assigned to said WD and located in a fixed location accessible by a WD user, said DRD being at least one of: a presentation projector, a video display, an ATM machine, and an Internet Kiosk; and

transferring the data to said DRD following commands entered by the WD user at said WD.

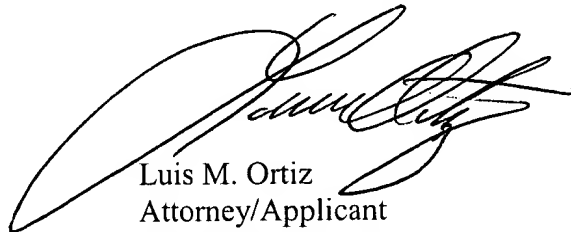
## VI. Conclusion

In view of the foregoing remarks, the applicants submit that Claims 1-4, 7-24, 30, 31, 79-82, 88-94, 97-102, and 104-105, which remain pending in the application, are patentably distinct over the references and are in allowable form. Accordingly, the applicants earnestly solicit the favorable consideration of their application, and respectfully request that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,

November 12, 2004



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